

Trademarks is petitioned, under 37 CFR 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 CFR 1.135. The fee under 37 CFR 1.17 should be charged to our Deposit Account No. 50-2215.

REMARKS

The rejections of claims 1-20 under 35 U.S.C. §103 over Ylitalo in view of either Knox or Tsuyoshi are respectfully traversed.

The Ylitalo reference relates to an ink-jet printing ink which has been specifically designed to overcome a specific problem, namely foaming when the ink contains a fluorinated surfactant. The ink must thus contain a fluorinated surfactant, colorant and a vehicle, and may also contain a plethora of other materials, all of which are optional. Twenty-one (21) categories of such optional materials are set forth in [0021]. One of the optional materials is an energy-curable material [0091]-[0093]

Another one of the Ylitalo optional components are solvents, which may be aqueous or organic, when present, are chosen to provide desired physical properties such as viscosity, and the like [0080]. Paragraph [0080] also states "For radiation curable ink, the solvent component is desirably absent. However, a small amount may be desirable under certain circumstances." The word "certain" has been underlined because it was omitted in the Final Rejection's quotation. That word is significant since it indicates the solvent may be desirable only under some circumstances, but it will be noted that Ylitalo never reveals what those circumstances constitute. Nevertheless, it is clear those circumstances do not relate to the presence of any solvent-soluble resin

because, as the Final Rejection has acknowledged, Ylitalo fails to teach or suggest a composition in which any solvent-soluble resin can be present.

MPEP 2143 states "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." It is respectfully submitted that no valid reason has been articulated.

Since Ylitalo's composition may or may not contain an energy-curable material, there must be a valid reason here to select the energy-curable material and then also to extract some teaching from the secondary references and incorporate it into Ylitalo. While the Final Rejection proffers reasons, they are not tenable, as they are retrospective constructs lacking any basis.

Both of the Knox and Tsuyoshi references teach compositions which can contain a solvent-soluble resin. But that fact, standing alone, is not a reason to incorporate the solvent-soluble resin in a composition like Ylitalo which cures by a different mechanism, namely polymerization or cross-linking, thereby requiring the presence of a photoinitiator [0086], and which is preferably solvent-free [0080].

The Final Rejection proposes that the reason to rely on Knox is that it "teaches that to get printed image with good adhesion, ink composition comprises the solvent-soluble resin" (page 3). It is respectfully submitted that there is no such teaching in Knox. The only reference to "good adhesion" in this reference is found at column 9, line 47 in the middle of a working example which does not attribute "good adhesion" to any type of resin, but rather attributes it to the manner in which a metal flake pigment was processed. Indeed, most of Knox is concerned with the manner in which the metal pigment is prepared. The function of the solvent-soluble resin disclosed in this

reference is to bind metal pigment flakes together to prevent them from becoming airborne as dust (col. 7, lines 20-22) as a result of grinding.

It is also asserted that Knox indicates the organic binder media "include" those habitually employed in inks. Disregarding that the binder need not be a solvent-soluble resin, the Final Rejection continues on page 6 by stating, without any factual basis, that it is "well known" solvent soluble resin is used in "the ink composition" and "it doesn't matter it is energy curable ink or regular ink." No document or Examiner affidavit, as required under MPEP 2144.03, is presented in support of this speculation. The assertion concludes with an assertion that the resin improves the application property, citing column 6, lines 65-67 which relates to liquid organic binders used as plasticizers in a composition which is not an energy-curable material.

The proposed justifications for combining Knox with Ylitalo are accordingly not valid.

The Final Rejection similarly proposes that the reason to rely on Tsuyoshi is that it "teaches that to get printed image with good adhesion, ink composition comprises the solvent-soluble resin (see Abstract; [0039])" (page 5). But there is no teaching in Tsuyoshi's Abstract or [0039], or anywhere else for that matter, about "good adhesion". This justification for the combination with Ylitalo is therefore untenable.

The Tsuyoshi printing ink contains a Monascus pigment which maintains its integrity until it is quickly discolored on exposure to visible light and/or ultraviolet light (see, *inter alia*, the Abstract). It describes ink jet inks which may contain a binder. The Final Rejection concludes just from the use of the word "binder" that any pigment based ink containing a binder must have "good binding characteristics to the medium",

providing an image with "good adhesion characteristics". This conclusion finds no basis in Tsuyoshi itself and no document or Examiner affidavit is presented in support of this baseless speculation about what properties a "binder" would provide to some unidentified "medium".

Any proposed reason for consulting a secondary reference must be to correct a deficiency or provide a feature lacking in the primary reference. Here, there is nothing in Ylitalo to suggest that its composition is deficient or lacks some feature. Beyond the fact that the proposed reasons are, at best, retrospective constructs, they fail to provide any answer to the question of why would one incorporate a solvent-soluble resin in the radiation curable composition which Ylitalo teaches should preferably not contain a solvent? A reason to use something in one reference is not, *ipso facto*, a reason to use it in a completely different set of circumstances. It is respectfully submitted that there are no reasons to combine references as proposed.

In view of the above amendment and remarks, applicant believes the pending application is in condition for allowance.

Dated: November 18, 2010

Respectfully submitted,

By /Edward A. Meilman/
Edward A. Meilman
Registration No.: 24,735
DICKSTEIN SHAPIRO LLP
1633 Broadway
New York, New York 10019-6708
(212) 277-6500
Attorney for Applicant